REMARKS

Claims 12-31 are pending in this application, with claims 30 and 31 withdrawn from consideration. Claims 12, 27 and 28 have been amended herein. Upon entry of this amendment, claims 12-31 will be pending, with claims 30 and 31 withdrawn from consideration.

The applicant respectfully submits that no new matter has been added. The amendment to claim 27 corrects a spelling error. The amendments to claims 12 and 28 are made for clarity only, as discussed below. It is believed that this Amendment is fully responsive to the Office Action dated **June 22, 2006**.

Claims 12-27 are rejected under 35 U.S.C. §112, first paragraph, because the specification, while being enabling for forming a microporous polyolefin membrane by a process which includes the essential step of stretching a gel-like article, does not reasonably provide enablement for conducting the process without practicing the essential step of stretching the gel-like article. (Office Action paragraph no. 3)

The rejection of claims 12-27 is respectfully traversed, and reconsideration of the rejection is requested.

Applicant notes that the Examiner appears to be implying that the specification states that the step of stretching a gel-like article is essential for practicing the invention. However, the Examiner has not pointed out where the specification purportedly states this.

Applicant submits that the specification does **not** state that stretching is essential for practicing the invention. For example, on page 3, line 2, the specification discloses: "treating, with a hot solvent, the gel-like formed article **or stretched product thereof** obtained by extruding a solution ...." (emphasis added). Here, the conjunction "or" clearly indicates that the method can be carried out with or without stretching the product. Page 9, last paragraph, also discloses the method: "... with or without stretching ...."

Applicant submits that nowhere does the specification state that stretching is "essential" for claims 12-27. Applicant believes that is possible in this regard that the Examiner has misinterpreted claim 28, which states "wherein stretching said gel-like article is an essential step." The meaning of this recitation is that stretching the gel-like article is an essential step **of claim 28**, that is, this defines claim 28. Since this is effectively a redundant recitation, Applicant has amended claim 28 for clarity to delete the "essential step" language.

Claims 12-29 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Office Action page 2, paragraph no. 4)

The Examiner states that claim 12 is indefinite because "the solution" on line 2 lacks antecedent basis. The rejection is overcome by the amendment of this phrase to "a solution." The comma after "a solution" is also deleted for grammatical correctness.

The Examiner states that claims 15-28 lack the phrase "any one of claims" before the multiple claims. This rejection is respectfully traversed. Claims 14-28 were all amended to remove multiple dependency in the preliminary amendment dated August 28, 2003, and none of these claims is a multiple dependent claim. Reconsideration is respectfully requested.

Claims 12, 13 and 16-29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Takita et al. (5,922,492). (Office Action paragraph no. 6)

The rejection is overcome by the assertion of the claim for foreign priority in this application, and by the assertion of common ownership in accordance with 35 U.S.C. 103(c).

The present application is a divisional of a U.S. national stage application of PCT/JP99/05345, filed on September 29, 1999. **September 29, 1999**, is therefore the effective U.S. filing date for the present application. The application also claims foreign priority of Japanese applications JP 10-294641 and JP 10-294642, each filed on October 1, 1998.

Takita et al. '492 was filed on May 28, 1997, and issued on July 13, 1999. Takita et al. '492 is therefore prior art under 35 U.S.C. 102(a) as of its July 13, 1999, issue date, and 102(e) as of its May 28, 1997, filing date.

Applicant submits that the assertion of the claim for foreign priority removes Takita et al. '492 as prior art under 35 U.S.C. 102(a). To perfect the claim for foreign priority, Applicant has here attached verified English translations of the two priority documents for the present application.

Applicant notes support for rejected claims 12, 13 and 16-29, in the priority documents, as well as for claims 14 and 15, as follows:

Support for independent claim 12 and dependent claims 13-15 of the present application may be found in claims 1-4, respectively, of Japanese Application H10-294642 (see page 1 of verified translation).

Claim 16: paragraph [0007], part (i) of Japanese Application H10-294642

Claim 17: paragraph [0007], part (ii) of Japanese Application H10-294642

Claim 18: paragraph [0007], part (iii) of Japanese Application H10-294642

Claim 19: paragraph [0007], part (iv) of Japanese Application H10-294642

Claim 20: paragraph [0007], part (v) of Japanese Application H10-294642

Claim 21: paragraph [0007], part (vi) of Japanese Application H10-294642

Claim 22: paragraph [0007], part (vii) of Japanese Application H10-294642

Claim 23: paragraph [0007], part (viii) of Japanese Application H10-294642

Claim 24: paragraph [0007], part (ix) of Japanese Application H10-294642

Claim 25: paragraph [0007], part (x) of Japanese Application H10-294642

Claim 26: paragraph [0007], part (xi) of Japanese Application H10-294642

Claim 27: paragraph [0007], part (xii) of Japanese Application H10-294642

Claim 28: paragraph [0007], part (xiii) of Japanese Application H10-294642

Claim 29: paragraph [0007], part (xiv) of Japanese Application H10-294642

With regard to Takita et al. as prior art under 35 U.S.C. 102(e), Applicant notes that the current 35 U.S.C. 103(c)(1) states that subject matter developed by another person which qualifies as prior art only under one or more of subsections 35 U.S.C. 102(e), (f) and (g) shall not preclude patentability where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person. This law now applies to all U.S. applications pending after December 10, 2004 (See MPEP 706.02(l)(1)(I)).

Since Takita et al. is disqualified as prior art under 35 U.S.C. 102(a) by assertion of the claim for foreign priority, Takita et al. would be prior art only under subsection 102(e), and 35 U.S.C. 103(c)(1) is applicable.

ASSERTION REGARDING COMMON OWNERSHIP

Applicant here asserts common ownership in accordance with MPEP 706.02(l)(2)(II):

The present application (USSN 10/649,732) and Takita et al. (U.S. Patent No. 5,922,492) were, at the time the invention of the present application was made, owned by Tonen Chemical Corporation.

The rejection of claims 12, 13 and 16-29 under 35 U.S.C. §103(a) as being unpatentable over Takita et al. (5,922,492) is thereby overcome.

If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the Applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, the Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

ARMSTRONG, KRATZ, QUINTOS,
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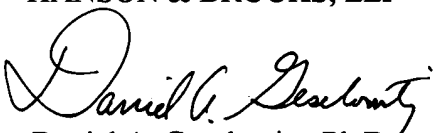

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PATENT TRADEMARK OFFICE

Enclosures: Verified English Translations of the two priority documents:
JP 10-294641 and JP 10-294642

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